

Remarks

Claims 15, 18, 19 and 20 have been amended to the recited mean pore size range. Specification support for these amendments may be found, *inter alia*, at page 18, lines 21-22. No new matter has been introduced by the amendments.

1. Rejection under 35 U.S.C. § 102(b) or § 103(a) based on Tomioka

Claims 15 and 18-30 are rejected as allegedly anticipated by or, in the alternative, as allegedly obvious over U.S. Patent 5,510,395 to Tomioka *et al.* ("Tomioka").

Applicants respectfully disagree with the Examiner's assessment of the pertinence of Tomioka to Applicants' claimed invention. Tomioka describes a polyimide porous film that is obtained by (a) applying a polyimide precursor solution to a metal foil having a uniform surface, (b) drying the resulting film on the metal foil, (c) removing the film from the surface of the metal foil and then (d) heating the film. Tomioka neither teaches nor suggests a laminate comprising a polyimide porous film and a metal layer. In contrast, Tomioka teaches a porous film that is temporarily in contact with a metal surface only during the film's preparation. Applicants submit that the citation asserted by the Examiner as teaching a laminate (*i.e.*, column 9, lines 55-60) refers only to an intermediate step in the ultimate manufacture of the polyimide film. All of the Examples in Tomioka support this submission as they describe a final step in which the film is removed from a metal surface. See, *e.g.*, Examples 5-8 at column 12, lines 29-32; Example 9 at column 13, lines 7-10; and Example 10 at column 13, lines 37-40. A person of ordinary skill in this art would not be motivated, after a reading of Tomioka, to prepare Applicants' claimed laminate. For at least this reason, Applicants respectfully request that this rejection be withdrawn.

2. Rejection under 35 U.S.C. § 103(a) over Tomioka in view of Adamopoulos

Claims 16 and 17 are rejected as allegedly obvious over Tomioka in view of U.S. Patent 5,326,643 to Adamopoulos *et al.* ("Adamopoulos"). The Examiner cites Adamopoulos for disclosing a semiconductor device comprising a laminate on an opposite side of the porous film from the metal layer.

Applicants respectfully disagree with the Examiner's assessment of the pertinence of Tomioka in view of Adamopoulos to Applicants' claimed invention. Applicants submit that Adamopoulos cannot overcome the deficiencies present in Tomioka as discussed above. Moreover, a person of ordinary skill in the art would not be motivated to combine Tomioka, which teaches away from a laminate, with

Adamopoulos, which teaches a polyimide adhered to a metal substrate. For at least these reasons, Applicants respectfully request that this rejection be withdrawn.

3. **Rejection under 35 U.S.C. § 103(a) over O'Neill in view of Adamopoulos**

Claims 15-29 and 31 are rejected as allegedly obvious over U.S. Patent 6,187,248 to O'Neill ("O'Neill") in view of Adamopoulos.

Applicants respectfully disagree with the Examiner's assessment of the pertinence of O'Neill in view of Adamopoulos to Applicants' claimed invention. Applicants submit that O'Neill simply describes a porous film having a pore size of less than 0.03 μm . O'Neill neither teaches nor suggests the use of a porous film with a mean pore size of about 0.05 to about 5 μm for the preparation of a laminate of a metal layer and said porous film. Adamopoulos cannot correct this deficiency present in O'Neill. For at least this reason, Applicants therefore respectfully request that this rejection be withdrawn.

4. **Rejection under 35 U.S.C. § 103(a) over O'Neill in view of Adamopoulos and further in view of Jasne**

Claim 30 is rejected as allegedly obvious over O'Neill in view of Adamopoulos and further in view of U.S. Patent 5,153,303 to Jasne *et al.* ("Jasne"). Applicants bring to the Examiner's attention that the inventor on this patent is Jasne and not Gilleo, as mistakenly indicated by the Examiner. The Examiner cites Jasne for teaching a polyimide formed from a biphenyltetracarboxylic acid and a paraphenylene diamine.

Applicants respectfully disagree with the Examiner's assessment of the pertinence of O'Neill in view of Adamopoulos and further in view of Jasne to Applicants' claimed invention. Applicants submit that Jasne cannot remedy the above-discussed deficiencies present in both O'Neill and Adamopoulos. For at least these reasons, Applicants therefore respectfully request that this rejection be withdrawn.

5. **Obviousness-type Double Patenting Rejection**

Claims 15-31 of the subject application are rejected as allegedly unpatentable over claims 15-27 of copending Application No. 10/785,413 in view of Adamopoulos.

Applicants disagree with the grounds for this rejection, which is provisional only. However, in an effort to expedite prosecution of the subject application, Applicants intend to file a terminal disclaimer over Application No. 10/785,413 if the claims in both applications are otherwise found allowable.

Conclusion

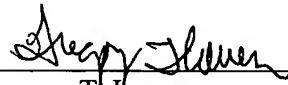
All claims are believed to be in proper form in all respects and a favorable action on the merits is respectfully requested. Should the Examiner feel that there are any issues outstanding after consideration of this amendment, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

Except for issue fees payable under 37 C.F.R. 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. 1.16 and 1.17 which may be required, including any required extension of time fees, or to credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **constructive petition for extension of time** in accordance with 37 C.F.R. 1.136(a)(3).

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